

## **REMARKS**

Claims 1, 2, 5-7, 11-14 and 16 are pending and under consideration. Claims 3, 4, 8-10, 15 and 17-21 have been canceled pursuant to the restriction requirement, mailed December 6, 2004. Claims 1, 5-7, 11-14 and 16 have been amended to cancel non-elected subject matter. Such cancellations and amendments have been made without prejudice to Applicants' right to pursue the subject matter recited in these claims in one or more continuation, divisional or continuation-in-part applications. Claims 5-7 and 11-12 have been amended to correct dependency. New claims 22-24 have been added. Support for newly added claims can be found, for example, in the specification on page 16, lines 14-15, and on page 26, lines 1-6. Upon entry of these amendments, claims 1, 2, 5-7, 11-14, 16 and 22-24 are pending and under consideration. No new matter has been added by these amendments. Applicants respectfully submit that the pending claims are allowable for the following reasons.

### **I. NONSTATUTORY DOUBLE PATENTING SHOULD BE WITHDRAWN**

Claims 1, 2, 5-7, 11-14 and 16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-19 of co-pending U.S. Application 10/748,085 ("the '085 application"). In particular, the Examiner alleges that the compound of formula (I) of the instant invention is obvious over the generic formula disclosed in the '085 application (Office Action, page 6). This rejection is respectfully traversed.

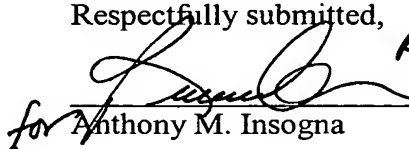
Applicant respectfully submit that the '085 application does not render the instant claims obvious as the claimed chemical structure and the compound cited in the art are structurally distinct.

The '085 application teaches a genus wherein  $R_1$  and  $R_2$  are, among others,  $-\text{CHF}_2$  and alkyl, with a requirement that at least one of  $R_1$  and  $R_2$  is  $-\text{CHF}_2$ . However, in the claimed genus,  $R_1$  and  $R_2$  are defined as  $\text{C}_{1-8}$ -alkyl, cycloalkyl, or  $(\text{C}_{1-4}$ -alkyl)-cycloalkyl. As such, the claimed genus is structurally different from the genus disclosed in the '085 application, and, therefore, the obviousness-type double-patenting rejection is improper. Accordingly, it is respectfully requested that the rejection of Claims 1, 2, 5-7, 11-14 and 16 under the judicially created doctrine of obviousness-type double patenting be withdrawn.

**CONCLUSION**

As '085 application is a pending application, it is respectfully requested that claims 1, 2, 5-7, 11-14, 16 and 22-24 be considered towards allowance.

No fee is believed to be due. However, the Commissioner is hereby authorized to charge any required fee(s) to Jones Day Deposit Account No. 50-3013 (referencing Attorney Docket No. 501872-999358).

Respectfully submitted,  
Date: June 2, 2005  
for    
Anthony M. Insogna Reg. No. 42,735  
Reg. No. 35,203

**JONES DAY**  
12750 High Bluff Drive, Suite 300  
San Diego, CA 92130  
(858) 314-1200